

### Provisional Election

In compliance with the requirements of 37 C.F.R. §1.143, applicants provisionally elect with traverse the composition comprising, as the thickener or dispersant, a copolymer obtained by the free-radical polymerization of the following monomer species:

- A) Acrylic acid,
- B)  $C_{14} - C_{24}$  monocarboxylic acids with 1 – 4 C—C multiple bonds [most frequently oleic acid],
- C) optionally N-vinylpyrrolidone and/or  $C_1 - C_{18}$ -alkyl(meth)acrylates,
- D) Allyl ethers of trimethylolpropane, pentaerythritol or sucrose with at least two allyl ether units per molecule [most frequently allyl ethers of pentaerythritol with at least two allyl ether units per molecule].

## Remarks

The Examiner's requirement for restriction is traversed. Applicants are thankful for the Examiner's diligent and thoughtful efforts in this matter and respectfully point out that "[a]lthough lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. ... rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant."<sup>1</sup>

This application is a national stage entry of PCT/EP02/00410, which was filed on January 17, 2002. Thus, the appropriate legal standard regarding restriction is whether "[t]he international application ... relate[s] to one invention only or to a group of inventions so linked as to form a single general inventive concept."<sup>2</sup> Furthermore, "[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."<sup>3</sup>

The present claims properly relate to a single general inventive concept. The claims of the present application require that cosmetic or pharmaceutical compositions are thickened by an effective amount of a copolymer which is the polymerization product of A) certain unsaturated carboxylic acids or their anhydrides, B) certain long-chain monomers, C) optionally other monomers, and D) certain cross linkers.

The utilization of such polymers as thickeners in pharmaceutical or cosmetic compositions "define[s] a contribution which each of the claimed inventions, considered as a whole, makes over the prior art,"<sup>4</sup> and therefore constitutes the "one or more of the same or corresponding special technical features," which are involved in the technical relationship between the embodiments of applicants' cosmetic or pharmaceutical

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<sup>1</sup> MPEP §1850 (emphasis added).

<sup>2</sup> PCT RULE 13.1.

<sup>3</sup> PCT RULE 13.2.

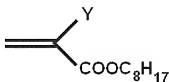
<sup>4</sup> PCT RULE 13.2.

compositions. Each embodiment of the claimed compositions requires this copolymer, thus the requirement of unity of invention referred to in Rule 13.1 is fulfilled. In other words, the present requirement for restriction is inappropriate under the proper “Unity of Invention” standard.

In the non-final Office action of September 28, 2006, the Examiner rejected all claims as anticipated by *Sonnabend* (US 4,384,096), and the Examiner now maintains the restriction requirement on the basis that “the general concept of the polymer has been shown not to be novel as seen in the initial Office action .... [and] cannot, therefore, be relied upon as the ‘special technical feature[.]’”<sup>5</sup> However, in the non-final Office action of September 28, 2006, the Examiner’s analysis regarding component B of *Sonnabend* was erroneous. Specifically, *Sonnabend*’s disclosure of “a non-ionic copolymerizable C2-C12 alpha, beta – ethylenically unsaturated monomer, preferably a monovinyl ester”<sup>6</sup> does not anticipate “alkyl esters of C8-C30 monocarboxylic acids” as claimed in the present application.

The only C8 alkyl structures that can theoretically be derived from the generic formula (II) of *Sonnabend* are:

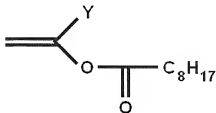
- a. Ester of unsaturated C3 monocarboxylic acid with saturated C8 alcohol



- b. Vinyl ester of saturated C9 monocarboxylic acid

<sup>5</sup> Paragraph 1 of the Office action mailed July 27, 2007.

<sup>6</sup> Abstract of *Sonnabend* (US 4,384,096).



Therefore, *Sonnabend* discloses neither components corresponding to B) (1), esters of unsaturated C8-C30 monocarboxylic acids, nor components corresponding to B) (3), esters of unsaturated C8-C30 alcohols, of this invention.

Additionally, *Sonnabend's*

liquid emulsion polymers ... require three essential components: (A) about 15 – 60 weight percent of a C<sub>3</sub>-C<sub>8</sub> α, β-ethylenically unsaturated carboxylic acid monomer, (B) 15 – 80 weight percent of a copolymerizable nonionic vinyl monomer, and (C) about 1 – 30 weight percent of certain nonionic vinyl surfactant esters.<sup>7</sup>

The amount of *Sonnabend's* monomer (A) is completely different from the amount of Applicant's monomer (A). Moreover, except for the similarity in their alpha-numeric designation as (B) and (C), *Sonnabend's* monomers (B) and (C) are completely different from Applicant's monomers (B) and (C). It should be clear, therefore, that the claimed cosmetic or pharmaceutical compositions are thickened by an effective amount of a copolymer that "define[s] a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."<sup>8</sup> This novel and unobvious copolymer therefore constitutes the "one or more of the same or corresponding special technical features," which are involved in the technical relationship between the embodiments of applicants' cosmetic or pharmaceutical compositions.

<sup>7</sup> Column 3, indicated lines 7 – 13 of US 4,384,096.

<sup>8</sup> PCT RULE 13.2.

In the non-final Office action of September 28, 2006, the Examiner also rejected all claims as anticipated by Gordi (SU 428347). The copolymers disclosed by Gordi do not comprise 0.05 – 5% by weight of cross-linking component D, as claimed. Again, it should be clear that the claimed cosmetic or pharmaceutical compositions are thickened by an effective amount of a copolymer that “define[s] a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”<sup>9</sup>

In Conclusion:

Contrary to the Examiner’s argument that “the general concept of the polymer has been shown not to be novel as seen in the initial Office action .... [and] cannot, therefore, be relied upon as the ‘special technical feature[,]’”<sup>10</sup> none of the cited art discloses a cosmetic or pharmaceutical composition containing as thickener or dispersant an effective amount of the novel and unobvious copolymer specified in the claims.

Especially in light of the MPEP’s instruction that “lack of unity of invention ... should neither be raised nor maintained on the basis of a narrow, literal or academic approach. ... [and that] the benefit of any doubt [should be] given to the applicant[,]”<sup>11</sup> the present requirement for restriction should be withdrawn.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner is welcome to contact the undersigned by phone to further the discussion.

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<sup>9</sup> PCT RULE 13.2.

<sup>10</sup> Paragraph 1 of the Office action mailed July 27, 2007.

<sup>11</sup> MPEP §1850 (emphasis added).